



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Simpson, et al.

Serial No.: 10/003,150

Filed: November 2, 2001

Group Art Unit: 3625

Examiner: Fadok, Mark

Docket No. 10008212-1

For: **Pay-For-Printing System and Method**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed August 25, 2006 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to arguments contained in Applicant's Appeal Brief. Applicant addresses those responses in the following. Applicant notes for the record that not every argument presented in Applicant's Appeal Brief was addressed in the Examiner's Answer, and Applicant incorporates each of those arguments by reference into the present Reply Brief.

A. "Printing Service"

In the Examiner's Answer, the Examiner states, in essence, that Applicant does not teach a "printing service". In view of that, the Examiner has interpreted that term to mean "the entire pay-for-print process as is defined in Fig. 8A and page 26, lines 11-21." *Examiner's Answer*, page 5.

In response, Applicant notes that, as identified in the Appeal Brief, Applicant's identification of support in the specification for limitations of Applicant's claims "appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure." *Appeal Brief*, page 3.

Applicant asserts that the Examiner's interpretation of the term "printing service" is not warranted by Applicant's disclosure. As an initial matter, under the plain and ordinary meaning of the term "service," a "service" is an entity that performs some action on behalf for another entity. By way of example, a "cleaning service" is an entity that performs cleaning for an individual or group of individuals. Applicant's specification provides a definition of the term "printing service" that is consistent with that form of interpretation. For example, Applicant identifies an "imaging destination 104" in relation to Figure 1 that performs "some form of

processing or manipulation” on user imaging data, such as printing. *See Applicant’s specification*, page 5, lines 11-14. Furthermore, Applicant identifies an “imaging destination service 218” in relation to Figure 2 that can comprise “a *print service* with which the document(s) can be printed. In such a scenario, a print request is communicated to the imaging destination service 218 and, upon receipt of the print request, the network server 208 interacts with the graphic store 220 and composition store 222 to retrieve the data needed to complete the print job. Once these data are retrieved, the network server 208 interacts with one or more printing devices (not shown) to which the server is coupled (directly or indirectly) to generate hard copy document(s).” *Applicant’s specification*, page 8, lines 13-17 (emphasis added). Applicant notes that the “printing service web content 318” identified in relation to Figure 3 is merely an indication of content that is stored by the web server 316 through which the “printing service” operates.

In view of the above, the term “printing service” should be interpreted in accordance with its plain and ordinary meaning and Applicant’s specification: a service that performs printing.

B. “Determining Printing Costs Based Upon Attributes of the Scaled-Down Version”

Next, the Examiner states that Applicant’s specification does not support the limitation “printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version”. In view of that argument, the Examiner interprets that phrase as meaning “downloading the thumbnail to a user so that the user can view the document/thumbnail to see if the image is desirable or printable.” *Examiner’s Answer*, page 6, lines 1-2.

The Examiner's argument as to Applicant's teachings are incorrect and the Examiner's interpretation of the phrase "printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version" is clearly unwarranted and improper. Regarding Applicant's specification, Applicant explicitly discloses: (i) a printing service retrieving a scaled down version of a document to be printed (*Applicant's specification*, page 25, lines 13-14), (ii) the printing service determining the cost for printing the document (*Applicant's specification*, page 26, lines 13-15), and (iii) the cost determination being dependent upon "the *nature* of the document to be printed" (*Applicant's specification*, page 26, lines 15-16 (emphasis added)). As to the "nature" of the document to be printed, Applicant's specification further states that the cost may be dependent upon, for example, "the toner or ink coverage that will result". *Applicant's specification*, page 26, line 19. Clearly then, the "nature" of a document, such as "the toner or ink coverage that will result," pertains to *attributes* of the document, i.e., the document's content. Furthermore, Applicant states that the scaled-down versions of the document "comprise a 'snapshot'" of the document" that "simplifies the printing cost estimate process that is undertaken by imaging destinations" such as the claimed printing service. *Applicant's specification*, page 23, line 22 to page 24, line 4. Therefore, Applicant provides explicit support for the limitation: "determining printing costs for printing the full-size document based upon attributes of the scaled-down version".

Turning to the Examiner's interpretation of the phrase "determining printing costs for printing the full-size document based upon attributes of the scaled-down version" to mean "downloading the thumbnail to a user so that the user can view the document/thumbnail to see if the image is desirable or printable," such an interpretation is clearly contrary to the plain and ordinary meaning of Applicant's limitation and to the definition of that limitation provided by

Applicant's specification as described above. Applicant asks: how can one reasonably interpret "[a] *printing service* determining printing costs for printing the full-size document based upon attributes of the scaled-down version"? Clearly one cannot. In short, there is no logical reason why one would interpret "printing service" to be a "user" (i.e., the "photographer" in the Garfinkle's system) as suggested by the Examiner. Furthermore, if the "printing service" of Applicant's claim were interpreted to simply mean the "user," it makes no sense that the user would "determine the printing costs". Applicant submits that an arrangement in which the user determines his own printing costs would not likely generate much revenue for the entity that performs the printing.

In view of the above, it is clear that the Examiner's interpretation is unreasonable. It is understandable, however, why the Examiner supports such an interpretation: Applicant's claims are allowable over the Garfinkle reference unless the claim language is contorted to fit the Examiner's interpretation. Specifically, as stated multiple times during prosecution, Garfinkle simply does not teach a system in which a "printing service" retrieves a scaled-down version of a document and determines printing costs based upon content of the scaled-down version.

C. Arguments in First Full Paragraph of Page 6

In response to Applicant's identification that Garfinkle does not teach a "printing service" retrieving a scaled-down version of a full-sized document to be printed, the Examiner attempts to characterize the term "photographer" as encompassing an operator of a printing service and cites Garfinkle's open-ended definition of "photographer" provided at the top of column 4. In response, Applicant notes that although Garfinkle's definition of "photographer" is broad enough to potentially include an operator of a printing service, Garfinkle does *not* provide an actual teaching that the "photographer" includes such an operator. By analogy, disclosure of a "vehicle" is broad

enough to encompass a “motorcycle,” although a mere teaching of a “vehicle” alone is not equivalent to an actual teaching of a “motorcycle.”

When one reviews Garfinkle’s disclosure it becomes apparent that the term “photographer” pertains to the actual photographer who captured the images and those he wishes to share his images with. This is evident from the various actions the “photographer” is described as taking in relation to the images, such as e-mailing them to another party, ordering prints or merchandise incorporating the images, etc. *See Garfinkle*, column 6, lines 10-19. Moreover, if Garfinkle intended the term “photographer” to include someone at a printing service, Applicant asks: why does Garfinkle further define a distinct “fulfillment center 20” that prints the images? Clearly, Garfinkle does not consider a printing service as an entity that qualifies as a “photographer,” and neither would a person having ordinary skill in the art.

Enigmatically, the Examiner further interprets the “printing service” to “encompass all of figures 1-9.” *Examiner’s Answer*, page 6. Applicant respectfully submits that such an interpretation is not only unwarranted but is ludicrous. The Examiner’s interpretation is completely invalid, particularly in view of Applicant’s identification of support for the term “printing service” provided above, and reveals the Examiner’s desperation in justifying the rejection.

D. Arguments in Second Full Paragraph of Page 6

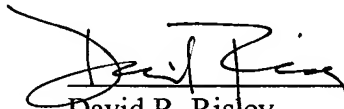
Next, the Examiner argues that Garfinkle teaches a “printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version” because the “photographer” can view his images in thumbnail form. Applicant has addressed this issue above. In short, there is no reasonable basis to interpret a “printing service” “determining printing

costs” from attributes of a scaled-down version of a document as the photographer merely reviewing his images. Applicant respectfully submits that if, as it appears, the Examiner’s entire case hinges upon the above interpretation, the rejections are clearly flawed and must be overturned. Applicant respectfully asserts that this is the case.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,



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PATENT APPLICATION

ATTORNEY DOCKET NO. 10008212-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Simpson, et al.

Confirmation No.: 7884

Application No.: 10/003,150

Examiner: Fadok, Mark

Filing Date: 11-2-01

Group Art Unit: 3625

Title: Pay-For-Printing System and Method

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PO Box 1450
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TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 8-25-06.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Respectfully submitted,

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